

REMARKS

This is in response to the Office Action mailed on May 10, 2005, and the references cited therewith.

Introduction

The Applicant's claim 1 and its dependent claims pertain to a "recirculating retainer" system and computerized method that, in one embodiment, provides at a high level for the following (for example as shown on pages 42-43 and in the corresponding flow charts and claims as filed):

- an **organization independent of a law firm** establishes a **client account** (for instance funds held in a bank account) to hold **funds** to be used to pay an agency a fee on behalf of a client, such as for filing a patent application;
- the "retainer" **funds** are provided initially by the client (the funds in this respect are like a retainer, but not necessarily governed by ethics rules that require the firm to manage the funds in a certain way because the **independent organization** as opposed to the law firm is holding the funds);
- a law firm uses these **funds** to pay, for instance but not by way of limitation, a **particular fee** to an agency, as noted above;
- the **independent organization** then invoices the law firm for the amount of the **particular fee** in order to **replenish** the **funds** for the amount of the **fee**;
- the law firm in turns invoices the client for the amount invoiced by the **independent party**;
- eventually the **client** pays the **law firm**, and the law firm in turn (not necessarily after the client pays) pays the **independent organization**;
- the **independent organization** then puts the **replenished** amount back in the **funds** for the **client**, thereby causing the **recirculation** of the amount used back to the funds.

None of the prior art known to the Applicant teaches the notion of such a recirculating retainer where an independent organization holds retainer funds and bills the

law firm in order to cause the replenishment of those funds by the law firm invoicing the client and in turn replenishing the funds in the retainer using client funds paid back to the law firm.

§112 Rejection of the Claims

Claims 1-16 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In paragraph 4 of the Office Action, the Examiner alleges that the “claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” In particular, the Office Action alleges that the Applicant’s Specification does not appear to be in agreement with the Applicant’s claim limitations. The Applicant respectfully traverses this rejection.

The operation set forth in pending claim 1, for instance, is described, in part, on pages 7-8 and 42-43 of the Applicant’s specification under the heading “Recirculating Retainer Feature.” In addition, claims 1-48 as filed with the Application on January 29, 1999, and thereby forming a part of the Applicant’s specification, also describe in part the operation of now pending claim 1. In addition, as set forth on pages 7-8 and 42-43 and elsewhere (the Applicant notes that the specification states that the described recirculating retainer feature is “amenable for inclusion with other embodiments of the invention described elsewhere in this application, as those of ordinary skill within the art can appreciate.” As stated on pages 42 and 43, the recirculating retainer features provides as stated therein:

“Referring to FIG. 3(b), in 1000, a charge is issued for a requested fee, associated with a matter of a client of a law firm, for payment to an agency such as the U.S. Patent and Trademark Office. The charge is payable against an account maintained by an organization separate from the firm, and the account itself is for the client. The account is initially funded by the client with a retainer or other payment, so that the account has an initial positive balance against which the charge can be paid.

Thereafter, in 1002, a client invoice is generated that includes the charge for the requested fee. This invoice is sent to the client. The client, in 1004, sends payment for

the charge -- even though the charge has been paid already out of funds already sent by the client -- so that the account can be replenished. In this way, the account retains a positive balance, against which other charges can then be made. This continual replenishment of the retainer in the account as charges are made against the retainer is referred to as a recirculating retainer.”

Claims 1-9, 15 and 16 as filed with the Application are set forth as follows:

1. A computer-implemented method for managing patent and trademark fees comprising:
inputting identification information for a matter of a client of a firm and a requested fee associated with the matter for payment to an agency as data representing the identification information into a computer workstation;

issuing a charge for the requested fee at the computer workstation for transmittal to the agency, the charge payable against an account maintained by an organization separate from the firm for the client, the account initially funded by the client such that the account has a positive balance; and,

generating a client invoice including the charge for the requested fee to replenish the account maintained by the organization so that upon payment by the client the account continually retains a positive balance.

2. The method of claim 1, further comprising:
receiving notice of an event for the matter of the client of the firm that will require a second fee associated with the matter for payment to the agency by a due date;
generating a second client invoice including a charge for the requested fee to pre-fund the account maintained by the organization such that upon payment by the client prior to the due date the account has a sufficient positive balance to cover the second fee.
3. The method of claim 2, wherein the charge included on the second client invoice for the requested fee is less than the requested fee, the account having a positive balance less than the requested fee.
4. The method of claim 2, wherein generating the second client invoice comprises generating the second client invoice at an accounting computer system of the firm.

5. The method of claim 2, wherein generating the second client invoice comprises:
generating the charge for the requested fee at a fee computer system of the organization;
transmitting data regarding the charge from the fee computer system to an accounting computer system of the firm; and,
generating the second client invoice at the accounting computer system.
6. The method of claim 2, wherein receiving notice of the event comprises:
receiving notice of the event at an accounting computer system of the firm; and,
transmitting data regarding the event from the accounting computer system to a fee computer system of the organization.
7. The method of claim 1, further comprising tracking a payment made by the client as covering one of an already made charge for a requested fee associated with a matter for payment to the agency and a charge to be made for a requested fee associated with a matter for payment to the agency.
8. The method of claim 7, further comprising issuing a refund to the client for regular payment made thereby for charges to be made requested fees associated with a matter for payment to the agency.
9. The method of claim 1, wherein payment made by the client comprises a charging of one of a credit card and a charge card of the client.
15. The method of claim 1, further comprising:
transmitting electronically data representing first information regarding the charge for the requested fee from the computer workstation to a fee computer system maintained by the organization;
inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system; and,

reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system.

16. The method of claim 15, further comprising:

generating data representing a fee invoice including the charge at the computer workstation and electronically transmitting the data representing the fee invoice to an accounting computer system maintained by the firm;

generating a firm invoice including the charge at the fee computer system for delivery to the firm,

wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice.

Applicant notes that the now pending claim 1 retains certain aspects of original claim 1, as repeated below:

1. (Previously Presented) A computer-implemented method for managing patent and trademark fees comprising:

inputting identification information for a patent or trademark matter of a client of a law firm and a requested fee associated with the matter for payment to an agency as data representing the identification information into a computer system;

deducting a charge for the requested fee against a client account maintained at least in part by an organization separate from the law firm for the client, the client account initially funded by the client such that the client account has a positive balance;

the organization generating a fee invoice to the law firm for the requested fee and transmitting the fee invoice to an accounting computer system used by the law firm;

generating a client invoice from the accounting computer system including a charge to the client for payment of the requested fee, wherein the payment of the requested fee is used to replenish the client account maintained by the organization, wherein the client invoice

corresponds to the fee invoice to the law firm such that payment by the client to the law firm for the client invoice provides funds to replenish the client account; and

replenishing the client account with the funds collected from payment of the client invoice for the requested fee.

Aspects carried over from the original claim 1, which corresponds at least in part to the above-noted sections of the Summary and Detailed Description sections of the Specification, include the following concepts:

identifying a patent and trademark matter for which a payment is due to an agency and inputting the information into a computer system;

using an account maintained by a third party to fund the payment;

generating a fee invoice to the law firm for the requested fee and transmitting it to a law firm accounting system;

generating a client invoice from the law firm accounting system, wherein the payment of the requested fee is used to replenish the client account maintained by the organization, wherein the client invoice corresponds to the fee invoice to the law firm such that payment by the client to the law firm for the client invoice provides funds to replenish the client account; and

replenishing the client account with the funds collected from payment of the client invoice for the requested fee.

Thus, the subject matter claimed by the Applicant is found in the claims as filed, which form part of the specification, and also in the sections of the specification noted. Therefore, withdrawal of the subject rejection under Section 112 is hereby requested.

Further, Applicant respectfully submits that the specification does provide enablement commensurate with the scope of claims 1-16. Support for claims 1-16 is found throughout the entirety of the present application. Some examples of this support are as follows:

Claim 1 is supported at page 7, line 18 – page 8, line 8; page 11, lines 8 – 19; page 12, line 20 – page 13, line 9; page 15, lines 5 – 21; page 19, line 23 – page 20, line 15; page 21, line 7 – page 22, line 15; and page 23, line 8 – page 24, line 1.

Claim 2 is supported at page 43, line 8 – page 44, line 22.

Claim 3 is supported at page 44, line 22 – page 45, line 7.

Claims 4-6 are supported at page 43, line 8 – page 45, line 7.

Claim 7 is supported at page 47, line 16 – page 50 line 1.

Claim 8 is supported at page 46, line 10 – page 47, line 3.

Claim 9 is supported at page 47, lines 4-14.

Claim 10 is supported at page 47, lines 5-8.

Claim 11 is supported at page 47, lines 8-10.

Claim 12 is supported at page 47, lines 11-14.

Claim 13 is supported at page 47, lines 11-14.

Claim 14 is supported at page 45, line 10 – page 46, line 9.

Claim 15 is supported at page 62, line 22 – page 63, line 13.

Claim 16 is supported at page 19, line 23 – page 20, line 15.

These cited portions of the specification, and referenced figures, among others, enable a person of ordinary skill in the art to make and use the invention commensurate with the scope of claims 1-16.

Claims 1-16 were also rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. It is believed the Introductory portion of this amendment explains how the system works. The particular scope of the invention claimed is set forth in the claims and the Applicant notes that the invention as claimed may include less particularity as to certain details that are not essential to the general computerized systems and methods taught in the Applicant's Specification. Thus, withdrawal of the § 112, 2nd paragraph rejection is respectfully requested.

§103 Rejection of the Claims

Claims 1-14 were rejected under 35 USC § 103(a) as being unpatentable over Remington et al. (U.S. Patent No. 6,070,150) in view of Brown (WO 96/10235).

Claims 15 and 16 were rejected under 35 USC § 103(a) as being unpatentable over Remington et al. (U.S. Patent No. 6,070,150) in view of Brown (WO 96/10235) further in view of Egendorf (U.S. Patent No. 5,974,221).

Applicant respectfully traverses these rejections because the combination of references fails to teach or suggest all of the claim elements. Further, the problem to be solved by the proposed combination of references is not contemplated by the references.

Remington discusses a system to present bills electronically, such as over the Internet. Brown discusses an automated accounting system for an individual or a business. Egendorf discusses a system in which an Internet service provider bills a customer for various purchases of third-party vendor products or services, such that the provider pays the vendor the billed amount minus a transaction fee. However, none of these three references contemplate identifying a particular matter of a client of a firm, or any other analogous system in which a regular client of an organization identifies a particular transaction by inputting matter identification. These references further fail to contemplate a firm or functionally similar organization inputting the matter identification and billing information into a computer system, but contemplates only a client's self-initiated online transactions.

These references further fail to contemplate an account maintained by any other organization analogous to the client account maintained separate from the firm in which deposits are made or that is funded to have a positive balance as recited in the claims.

Additionally, the references fail to consider generating an invoice for such services, as neither the services nor account are present, but further fail to consider calculating a bill payable to the account associated with the client in such a way as the account maintains a positive balance.

Thus, the combination of references fails to teach or suggest all the elements of claims 1-16 at least because they fail to contemplate a particular matter of a client of a firm or the arrangement of the law firm, organization, invoicing, and data exchange as presently claimed.

Further, the problems to be solved by the proposed combination of references is not contemplated by the references. The problems to be solved by the present inventive subject matter is discussed in the application and include resolving tax issues with regard to paying client fees and expenses, solving law firm cash flow issues, and eliminating ethical issues that

can arise from loaning funds to clients. These problems are not found anywhere within the cited references. Thus, it appears that the Office Action is using Applicant's disclosure and claims as a template in combining references. Or stated otherwise, the Office Action is using impermissible hindsight.

Thus, Applicant respectfully requests reconsideration and allowance of claims 1-16.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6902 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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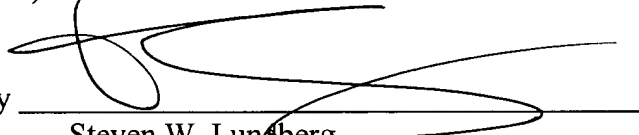
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of October, 2005.

LISA POSORSKE

Name



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